

ESTTA Tracking number: **ESTTA527091**

Filing date: **03/15/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Skullcandy, Inc.
Granted to Date of previous extension	03/16/2013
Address	1441 Ute Boulevard, Suite 250 Park City, UT 84098 UNITED STATES

Attorney information	Matthew A. Barlow Workman Nydegger 60 E. South Temple, Suite 1000 Salt Lake City, UT 84111 UNITED STATES mbarlow@wnlaw.com, vgarrett@wnlaw.com Phone:801-533-9800
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Applicant Information

Application No	85739358	Publication date	01/15/2013
Opposition Filing Date	03/15/2013	Opposition Period Ends	03/16/2013
Applicant	VALOR COMMUNICATION, INC. 18071 Arenth Avenue City of Industry, CA 91748 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: CELL PHONE ACCESSORIES, NAMELY, CELL PHONE CASES, CELL PHONE BACK PLATES AND FACE PLATES

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3168695	Application Date	01/10/2006
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2003/01/12 First Use In Commerce: 2003/01/12 Devices for hands-free use of mobile phones; [Digital audio players; Digital phones; Earphones;] Headphones [; MP3 players; Portable listening devices, namely, MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets]


U.S. Registration No.	3726304	Application Date	07/30/2008
Registration Date	12/15/2009	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/03/01 First Use In Commerce: 2003/03/01 Retail store services, kiosks and online retail store services featuring devices for hands-free use of mobile phones, digital audio players, digital phones, earphones, headphones, MP3 players, portable listening devices, namely, MP3 players, portable media players, covers for portable media players, digital phones, earphones, and headphones, protective helmets, protective helmets for sports, sports helmets, watches, sacks or bags, namely, backpacks, messenger bags, all purpose sports and athletic bags, sunglasses, clothing and headwear, namely, t-shirts, sweatshirts, hats, and bandanas		

U.S. Registration No.	3381050	Application Date	06/12/2007
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Clothing and headwear, namely t-shirts, sweatshirts, and hats

U.S. Registration No.	3788707	Application Date	01/23/2009
Registration Date	05/11/2010	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2005/12/01 First Use In Commerce: 2005/12/01 Bags, namely, backpacks, book bags, sports bags, and handbags		

U.S. Registration No.	3880588	Application Date	01/23/2009
Registration Date	11/23/2010	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2010/06/15 First Use In Commerce: 2010/06/15 Bags, namely, wallets

Attachments	78788980#TMSN.jpeg (1 page)(bytes) 77534577#TMSN.jpeg (1 page)(bytes) 77204362#TMSN.jpeg (1 page)(bytes) 77979143#TMSN.jpeg (1 page)(bytes) 77655458#TMSN.jpeg (1 page)(bytes) SKULLCAP Notice of Opposition (16367.22.35).pdf (7 pages)(128629 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Matthew A. Barlow/
Name	Matthew A. Barlow
Date	03/15/2013

trademark to be used in International Class 009, as evidenced by the publication of such mark in the Official Gazette on TM 633 of the January 15, 2013 issue, in conjunction with goods identified as “cell phone accessories, namely, cell phone cases, cell phone back plates and face plates.”

2. Applicant filed an intent-to-use application for registration of the SKULLCAP Mark on September 26, 2012, and received an application serial number of 85/739,358 (“the SKULLCAP Mark”).

3. Since at least as early as 2003, Opposer has developed and continuously used the mark “SKULLCANDY” on or in connection with various goods, including headsets, headphones, ear buds, earphones, portable speakers, clothing, backpacks, book bags, sports bags, and handbags, in interstate commerce throughout the United States and throughout the world.

4. Opposer is the owner of the following relevant trademarks which have been registered with the United States Patent and Trademark Office (collectively, the “SKULLCANDY MARKS”):

Registration No.	Mark	Goods and Services
3,168,695	SKULLCANDY	Devices for hands-free use of mobile phones; Earphones; Headphones (International Class 009)
3,726,304	SKULLCANDY	Retail store services, kiosks and online retail store services featuring devices for hands-free use of mobile phones, digital audio players, digital phones, earphones, headphones, MP3 players, portable listening devices, namely, MP3 players, portable media players, covers for portable media players, digital phones, earphones, and headphones, protective helmets, protective helmets for sports, sports helmets, watches, sacks or bags, namely, backpacks, messenger bags, all purpose sports and athletic bags, sunglasses,

		clothing and headwear, namely, t-shirts, sweatshirts, hats, and bandanas (International Class 035).
3,381,050	SKULLCANDY	Clothing and headwear, namely t-shirts, sweatshirts, and hats (International Class 025).
3,788,707	SKULLCANDY	Bags, namely, backpacks, book bags, sports bags, handbags (International Class 018)
3,880,588	SKULLCANDY	Bags, namely, wallets (International Class 018).

5. Since the date of issuance of the SKULLCANDY MARKS, the SKULLCANDY MARKS have been continuously used in interstate commerce. Since the issuance of the SKULLCANDY MARKS, notice has been given to the public that the SKULLCANDY MARKS are registered trademarks by affixing notice provided in 15 U.S.C. § 1111.

6. Since at least as early as 2003, Opposer has been engaged in the development and sale of various goods and services, including headphones, ear buds, earphones, portable audio speakers, cell phone covers, mp3 player covers, clothing, backpacks, book bags, sports bags, and handbags, in interstate commerce throughout the United States and the world, in association with the SKULLCANDY MARKS. The goods and services offered by Opposer in association with the SKULLCANDY MARKS are such that the consuming public will likely be confused as to the source of the goods offered by Applicant.

7. Further, since Opposer's initial use of the SKULLCANDY MARKS, Opposer has made a substantial investment in marketing and promoting its goods and services under its SKULLCANDY MARKS. Opposer has used, advertised, promoted and offered for sale goods and services in association with its SKULLCANDY MARKS with the result that Opposer's customers and the general public have come to know and recognize the SKULLCANDY MARKS and that the public associates these marks with Opposer and/or its goods and services.

8. Opposer has used the SKULLCANDY MARKS to distinguish its products, including, but not limited to, headsets, headphones, ear buds, earphones, portable audio speakers, cell phone covers and cases, mp3 player covers and cases, laptop sleeves, clothing, backpacks, book bags, sports bags, and handbags, from other goods of the same type. Opposer's SKULLCANDY MARKS are distinctive and serve as a unique designation of origin with respect to the goods and services offered by Opposer. Opposer has acquired substantial goodwill in the SKULLCANDY MARKS through use thereof.

9. Notwithstanding the inherent distinctiveness of the SKULLCANDY MARKS and, Opposer's SKULLCANDY MARKS have also acquired secondary meaning to the public indicating Opposer as the source of goods and services bearing the SKULLCANDY MARKS.

10. Applicant's mark identified in its application is confusingly similar to the SKULLCANDY MARKS. Applicant's mark is confusingly similar in sound, spelling, and appearance to the SKULLCANDY MARKS owned by Opposer. Applicant's mark wholly incorporates the "SKULLCA" word portion of the SKULLCANDY MARKS, omitting solely the last three letters of the SKULLCANDY marks ("-NDY") and adding a single ending letter in their place ("-P"). As a result, Applicant's mark is likewise similar in connotation with the SKULLCANDY MARKS owned by Opposer.

11. As evidenced by the goods identified in Applicant's application, the SKULLCAP Mark is applied to goods that are closely related, if not identical, to the goods and services provided by Opposer under its SKULLCANDY MARKS, such as cell phone accessories, cell phone cases, cell phone back plates, and face plates. Thus, Applicant's mark coupled with the goods for which registration is sought so nearly resembles Opposer's SKULLCANDY MARKS and the goods and services upon which they are used, so as to be likely to be confused therewith

and mistaken therefore and to confuse, mislead and deceive the consuming public as to the source or origin of Applicant's goods, cause confusion or mistake as to the origin, sponsorship or approval of Applicant's goods, services and/or commercial activities, and/or cause confusion or mistake as to the affiliation, connection or association of Applicant and Opposer.

12. Applicant's use of the mark identified in its application and in the manner described therein creates a likelihood of confusion with the SKULLCANDY MARKS. The likelihood of confusion in the marketplace exists between the SKULLCANDY MARKS and Applicant's mark when applied to the goods and services of the respective parties.

13. If Applicant is permitted to register its mark for its goods as specified in the application herein opposed, such registration would result in confusion in the trade by reason of the similarity between Applicant's mark and the SKULLCANDY MARKS, thereby damaging and injuring Opposer. Any such confusion may result in the loss of business to Opposer. Furthermore, any defect, objection or fault in the goods sold by Applicant under its mark may reflect upon and injure the reputation which Opposer has established for its products and services sold in association with or using the SKULLCANDY MARKS.

14. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie right to the use of its mark. Such registration would be a further source of damage to Opposer.

15. In view of the foregoing, Applicant is not entitled to federal registration of its claimed mark because Applicant's mark as used upon its identified goods is not entitled to protection. Further, Applicant does not have a right to exclusive use of said mark in commerce on Applicant's goods. Applicant's claimed mark does not and cannot function to identify such goods and to distinguish them from goods offered by Opposer.

WHEREFORE Opposer requests that the registration sought by Applicant be refused and that this Opposition be sustained.

The fee required under 37 C.F.R. § 2.6(17) is being submitted herewith.

DATED this 15th day of March, 2013.

Respectfully submitted,

By: /Matthew A. Barlow
Michael J. Frodsham (Reg. No. 48,699)
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Attorneys for Opposer
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served on Applicant by mailing a true copy thereof to its attorney of record, via First Class Mail, postage prepaid this 15th day of March, 2013, in an envelope addressed as follows:

THOMAS ROSZA
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/Matthew A. Barlow

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